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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,439	04/01/2004	Panu K. Zoller	53766US010	2823
33692 7590 08/28/2009 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER CHANG, VICTOR S				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 08/28/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PANU K. ZOLLER; EUGENE G. HENNEN

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Reissue Application 10/817,439  
Patent 6,365,254  
Technology Center 1700

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Mailed: August 28, 2009

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Before LYNN M. KRYZA, *Deputy Chief Trial Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This reissue application was electronically received by the Board of Patent Appeals and Interferences on August 24, 2009. A review of the reissue application revealed that it is not ready for docketing as an appeal. Accordingly, the reissue application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

## REISSUE AMENDMENTS NOT IN COMPLIANCE WITH 37 CFR 1.173

A review of the amendments filed by applicant on *December 19, 2005, March 28, 2006 and June 22, 2007*, reveals that the claim amendments are not in proper format. The copy of claims 40-53 and 55 should be in proper format and must contain markings such as brackets or underlining in accordance with 37 C.F.R. 1.173(d). *See also Manual of Patent Examining Procedure* (MPEP) § 1453 (8<sup>th</sup> ed. Rev. 6, Sept. 2007). Appropriate correction of all claims to be in proper format pursuant to 37 C.F.R. § 1.173 is required. It is noted that the claims 40-53 and 55 in the “claims appendix” section of the “appeal brief” submitted on March 10, 2009 contain markings which are compliant; therefore, any amendments or corrections submitted should match the “claim appendix” in the latest submission of the brief.

*Please also note* that the newly added claim numbers: 40-53 and 55 have been designated as “original” in several amendments; however, the appeal brief lists them as “new”. The claims should have been listed as “new” throughout prosecution of the case, and be completely underlined, in accordance with 37 C.F.R. § 1.173.

## REISSUE AMENDMENT, SUPPLEMENTAL DECLARATION REQUIRED

The Amendments dated *December 19, 2005, March 28, 2006 and June 22, 2007* do not appear to have been accompanied by a supplemental reissue declaration. Whenever claims are amended or added, a supplemental reissue declaration is required pursuant to MPEP 1414.01. Form PTO/SB/51S, “Supplemental Declaration For Reissue Patent Application To

Correct 'Errors' Statement ([see] 37 C.F.R. § 1.175(b)(1)),” may be used to prepare a supplemental reissue declaration. Form PTO/SB/51S serves to indicate that every error in the patent that was corrected in the reissue application, but was not covered by a prior reissue oath/declaration submitted in the reissue application, arose without any deceptive intention on the part of the applicant.

#### REJECTION OF ALL THE REISSUE CLAIMS UNDER 35 U.S.C. 251

It does not appear that the Examiner has included in an Office action the appropriate rejection of all the reissue claims under 35 U.S.C. 251, as being based upon a defective reissue declaration, and the requirement of a supplemental reissue declaration signed by the reissue applicant to overcome such rejection. See MPEP § 1414.01 and MPEP § 1444 for details.

#### CONCLUSION

Accordingly, it is

ORDERED that the application be returned to the examiner for the following:

- 1) mail a communication requiring submission of an amendment in compliance with the format and status identifier requirements of 37 C.F.R. § 1.173, as well as requirement of a supplemental declaration per MPEP 1414.01 and MPEP § 1444; and,
- 2) for such further action as may be appropriate.

Reissue Application 10/817,439  
Patent 6,365,254

If there are any questions pertaining to this Order, please contact the  
Board of Patent Appeals and Interferences at 571-272-9797.

LMK/MAT

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